

## **REMARKS**

### **I. Rejection under 35 USC §103**

Claims 1-12 stand rejected under 35 U.S.C. §103(a) as being anticipated by U.S. Pat. No. 5,668,862 to Bannister et al. ("Bannister") in view of U.S. Pat. No. 5,978,451 to Swan et al. ("Swan") and further in view of U.S. Pat. No. 6,035,190 to Cox et al. ("Cox"). Applicants respectfully traverse the rejection. However, to expedite prosecution in the present application, claims have been amended to better define the invention.

Bannister discloses a method for subscribers to screen incoming calls based on the role of the telephone number dialed by a caller (Col. 2, lines 11-32). The caller places a call to a particular telephone number associated with a role of the subscriber, such as "private," "business," or "social" roles. For instance, the subscriber may provide one telephone number for "private" purposes (Col. 8, lines 44-64). When a caller calls the private telephone number, the service node takes control of the call and routes it to the alerting device identified by the profile of the subscriber. The alerting device may be a cellular telephone, such that the subscriber would then receive the call at his cellular telephone, along with an indication of the Caller ID of the caller, the name of the caller, and the role associated with the telephone number dialed (Col. 9, lines 21-63). Moreover, the subscriber chooses one alerting device at a time to receive the calls to each of his telephone numbers (Col. 9, lines 56-63).

Swan discloses a personal communications system ("PCC") that is subscriber premise equipment to manage residential communications with a plurality of telephone terminals. By being connected at the subscriber residence, the PCC is able to ring different phones on the same telephone line within a single house differently, according to the incoming call; block calls or ringing depending on time of day or user preference; operate in conjunction with a subscriber's personal computer to keep call records; and perform other features.

Cox discloses a method that allows a caller who has begun a directory service session to interrupt a call and return to a directory assistance service operator upon receiving a DTMF signal issued by the customer. The method is expected to be advantageous to those who have cell phones and may not be able to write down a given telephone number.

**A. The rationale for combining the references is improper according to MPEP §2143.01, §2144, and §2145(X)**

1. The proposed modification changes the principle of operation of at least one of the references

Bannister is directed to call-monitoring by the subscriber of its service so that the subscriber may decide what calls to take, depending on the nature of the call. Further, in Bannister, a caller calls one of a plurality of phone numbers—all corresponding to a single subscriber—so as to be forwarded to a single alerting device, chosen by the subscriber. The subscriber chooses the single alerting device depending on where he is, so that he may receive all of the calls to all of his various numbers at that one location. Bannister allows the subscriber to be in control of the routing of all of his incoming calls to all of his telephone numbers.

Conversely, claims 1, 5, and 9 recite an ability to route a single telephone call to a variety of destinations, at the option of the caller. The claimed invention gives the caller control, while Bannister gives the subscriber and not the caller control. To modify Bannister to give the caller control would change the principle of operation of Bannister. (MPEP §2143.01, §2145(X))

Moreover, modifying Bannister to interrupt a telephone call routed to a first number of the plurality of phone numbers, in order to route the call to a second number of the plurality of phone numbers, would be counterproductive.

First, in a sense, the caller in Bannister has already chosen where they would like to reach the subscriber by calling one of the plurality of phone numbers corresponding to the subscriber. The caller is then forwarded to the

alerting device, where the subscriber should be actually located. Once the caller is forwarded to the alerting device, the caller should reach the subscriber—if the subscriber is available anywhere on the system. For this reason, the caller would not need to interrupt the telephone call and be rerouted to a second number of the plurality of telephone numbers.

Second, the Bannister system prefers the caller to stay on the line if there is no answer, in order to leave a voice mail. This allows the subscriber to screen the incoming call to determine whether he wishes to take the call (Col. 2, line 63-Col. 3, line 5; Col. 12, lines 30-67). Modifying Bannister to allow a caller to interrupt a voice mail message acts against the Bannister "method of providing improved call screening to subscribers" (Col. 3, lines 6-9).

Swan provides a PCC which is located at a subscriber residence. By being located at the residence, a subscriber is able to easily access the PCC to provide a variety of services—including being linked to a subscriber personal computer, ringing different phones on the same telephone line, or pressing a button on the PCC to enter a "do not disturb" mode.

Conversely, amended claims 1 and 9 recite providing a menu from a network element, and claim 5 recites at least one service control point having service logic to provide a menu. The claimed invention provides a menu from outside the subscriber residence, but Swan provides a single device providing a multitude of advantages by being located at the subscriber residence. Removing Swan from the subscriber residence would change the principle of operation of Swan.

2. The proposed modification renders at least one of the references unsuitable for its intended purpose

To modify Bannister to provide the caller control recited in claims 1, 5, and 9, would render the Bannister system unsuitable for its purpose of providing a central forwarding point—the subscriber-selected alerting device—for calls to a

variety of numbers corresponding to a single subscriber. (MPEP §2143.01, §2145(X)) The Bannister system provides subscribers increased control over their calls by forwarding calls to the alerting device, so that the subscriber may decide what to do with the calls. Modifying Bannister to allow the caller to be routed, for instance, to the home of the subscriber or to the office of the subscriber would **prevent** the subscriber from receiving and screening the telephone call at his mobile phone alerting device. The subscriber would then miss his calls instead of receiving them centrally at his alerting device, returning him to the situation he was in prior to the Bannister device.

3. The rationale to combine the references is improper

"The rationale to modify or combine the prior art...may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law" (MPEP §2144).

The rationale identified by the Office Action was to combine the references in order to provide the caller controls over selecting his/her desired destination, and in the event of there is no answer from the first destination or the caller changes his/her mind after the first selection, the caller would have a chance to interrupt the telephone call to the first telephone number and select another destination without re-dialing the PCS number. (Office Action, pg. 4)

The rationale identified by the Office Action was not noted as expressly or impliedly contained in the prior art. Nor is the rationale reasoned from established scientific principles, legal precedent, or knowledge generally available to one of ordinary skill in the art. If the Examiner wishes to rely on common knowledge, he is respectfully requested to identify the **technical** basis for such a reliance according to MPEP §2144.03. Otherwise, the rationale can only be attributed to the disclosure of the Applicant, which is impermissible hindsight.

Particularly with regard to the Cox reference providing a DTMF signal to interrupt a directory assistance call, there appears to be no suggestion in the Cox reference—or in the Bannister and Swan references—to combine the DTMF functionality with the Bannister and Swan devices. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (MPEP §2143.01).

**B. The combination does not disclose or suggest all elements of the claims**

Amended claims 1 and 9 recite "providing a menu from a network element in a telephone call" and claim 5 recites "at least one service control point having service logic...to direct acts of: providing a menu in the telephone call." None of the references, alone or in combination, provide a menu from a network element or a service control point. The "service node" in Bannister does not provide a menu in a telephone call, nor is any menu provided in a telephone call in Bannister. Further, there is no suggestion for the PCC of Swan to provide a menu from a network element or to direct acts as a service control point, because of the advantages that the PCC has because of its location in the subscriber residence.

Amended claims 1, 5, and 9 recite "receiving a second selection of one of the destination options in the telephone call." None of the cited references, alone or in combination, disclose or suggest the receiving of a second selection of a plurality of destination options.

**II. Double Patenting Rejection**


Claims 1, 2, 5, 6, 9, and 10 stand provisionally rejected under the judicially-created doctrine of obviousness-type double patenting over claims 1, 3,

6, 8, 12-14, and 16 of U.S. Pat. No. 6,327,354. A terminal disclaimer is filed with this Amendment, rendering the rejection moot.

III. Conclusion

For all of the above reasons, Applicants respectfully request reconsideration and allowance of the present claims. The Examiner is invited to contact the undersigned attorney at (312) 222-8101 if there are any outstanding issues that could be resolved through a telephone conference.

Respectfully submitted,



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